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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/761,773	01/21/2004	Terry Durand	ATT-187	3533
65667 7590 03/04/2009 AT&T Legal Department - Moazzam Attn: Patent Docketing Room 2A-207 One AT&T Way Bedminster, NJ 07921				
EXAMINER				
KEEFE, MICHAEL E				
ART UNIT		PAPER NUMBER		
2454				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/761,773

**Applicant(s)**

DURAND ET AL.

**Examiner**

MICHAEL E. KEEFER

**Art Unit**

2454

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 January 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3-5,8-10,13,15-23 and 25 is/are pending in the application.
- 4a) Of the above claim(s) 13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-5,8-10,13,15-23 and 25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. This Office Action is responsive to the Amendment and RCE filed 1/9/2009.

***Specification***

1. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: The term "computer-readable medium" as recited in claim 25 is not found in the specification.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1, 3-5, 8-10, and 15-23 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The word "its" found in line 5 of claim 1 and line 6 of claim 15 is confusing as it is unclear as to what the pronoun is referring to. The pronoun should be deleted and the claims appropriately amended for clarity.

Claims 3-5, 8-10, and 16-23 are rejected for being dependent upon rejected claims 1 and 15.

***Claim Rejections - 35 USC § 103***

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claims 1, 3-5, 8-9, 15-22, and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ostermann et al. (US 6963839), hereafter Ostermann in view of Issacs.

Regarding **claims 1, 15 and 25**, Ostermann discloses:

A method of using an electronic communications network, in which a sender can send a message to a recipient, the network including a server for facilitating communications between the sender and the recipient, (Fig. 4(a), 4(b)) the method comprising the steps of:

linking a sound file to an emoticon contained in a sender-generated message; and forwarding the emoticon and its link to the sound file to the recipient. (Col. 8, lines 17-28 disclose linking video and audio to a sender-generated message containing emoticons. Col. 9 lines 59-61 disclose determining sounds to link with the message based off of emoticons. It is inherent that the message is forwarded to the recipient, or else there would be no reason to construct it at all. (Note recipients 72 and 76 in fig. 4a and 4b)

wherein the linking occurs at the server according to user preferences stored on the server. (Col. 8, lines 17-28 disclose linking video and audio to a sender-generated message containing emoticons. Col. 9 lines 59-61 disclose determining sounds to link with the message based off of emoticons. See Col. 10, lines 49-65 for the storage of user preferences (i.e. language) on the server))

Ostermann discloses all the limitations of claims 1, 15, and 25 except for determining if the recipient has a file prior to sending the file.

The general concept of allowing a recipient to cache files is well known in the networking art as taught by Issacs (see Fig. 5, steps 220, 240, and 250).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Ostermann with the general concept of allowing a recipient to cache files as taught by Issacs in order to decrease network traffic and message size.

Regarding **claims 3 and 16, as applied to claims 1 and 15**, Isaacs teaches:

making a dynamic association, established by the sender, for that particular message being sent. (Fig. 3 discloses linking particular sounds to particular icons creating specific 'earcons', which are particular messages made by the user dynamically.)

Regarding **claims 4 and 17 as applied to claims 1 and 15**, Isaacs teaches:

automatically generating a link according to the particular emoticon being sent. ([0031] discloses that a sound is automatically chosen based upon the icon chosen by the user for the message.)

Regarding **claims 5 and 18 as applied to claims 1 and 15**, Isaacs teaches:

automatically generating a link according to the combination of the particular emoticon being sent and the particular recipient. ([0021] discloses sending different sounds to different recipients depending upon the particular recipient (i.e. has that recipient received a message from the user within a certain amount of time, if not, link a sound file including the user's personal sound.)

Regarding **claims 20, as applied to claim 15**, Isaacs teaches:

wherein the step of linking is performed by the sender. (Fig. 3)

Regarding **claims 8 and 21, as applied to claims 1 and 15**, Isaacs teaches:

wherein the step of linking comprises attaching the sound file to the message, and wherein the step of forwarding comprises forwarding both the message and the sound file. ([0039] discloses sending a sound file with the message.)

Regarding **claims 9 and 22, as applied to claims 1 and 15**, Isaacs teaches:

creating a pointer to a sound file and attaching the pointer to the message. ([0037] discloses including a unique ID that indicates the sound file with the message.)

Regarding **claim 19 as applied to claim 15**, Ostermann discloses:

The linking is preformed on the server. (Col. 8 lines 17-28 disclose that the linking is done by a server.)

6. Claims 10 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ostermann and Issacs as applied to claims 1 and 15 above, and further in view of Mages et al. (US 6463467), hereafter Mages.

Ostermann and Issacs teach all the limitations of claims 10 and 23 except for forwarding the emoticon and its link as a mime-encoded attachment.

Mages teaches:

forwarding the emoticon and its link to the sound file in the form of an MIME-encoded attachment. (Col. 3, line 5 discloses using MIME encoded attachments.)

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Ostermann and Issacs with the general concept of MIME-encoding files as taught by Mages in order to decrease network traffic and message size.

### ***Response to Arguments***

7. Applicant's arguments filed 1/9/2009 have been fully considered but they are not persuasive.
8. Applicant's arguments regarding the rejections under 35 U.S.C. 102(e) are moot, as those rejections are withdrawn due to Applicant's Amendment. The same applies to the rejections under 35 U.S.C. 103(a) under Mages in view of Issacs.
9. Applicant argues that Ostermann does not disclose linking of sound files already on the server with an emoticon. The Examiner disagrees with Applicant that the claims require the sound file already be on the server. The Examiner has pointed out above where any newly added limitations may be found in the references of record. The Examiner also notes that Applicant's claims do not require the 'sender' and 'server' to be separate entities.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL E. KEEFER whose telephone number is (571)270-1591. The examiner can normally be reached on Monday through Friday 9am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan Flynn can be reached on (571) 272-1915. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MEK 2/26/2009

/Dustin Nguyen/

Primary Examiner, Art Unit 2454